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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/037, 315	03/09/98	NELSON	S 744-P-4

IM22/1124

EXAMINER

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AHMAD, N

ART UNIT	PAPER NUMBER
1772	4

DATE MAILED: 11/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**09/037,315**

Applicant(s)

**Nelson**

Examiner

**Nasser Ahmad**

Group Art Unit

**1772** Responsive to communication(s) filed on Aug 20, 1999. This action is **FINAL**. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims** Claim(s) 1-10 is/are pending in the application.Of the above, claim(s) 1-7 is/are withdrawn from consideration. Claim(s) \_\_\_\_\_ is/are allowed. Claim(s) 8-10 is/are rejected. Claim(s) \_\_\_\_\_ is/are objected to. Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers** See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner. The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119** Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All  Some\*  None of the CERTIFIED copies of the priority documents have been received. received in Application No. (Series Code/Serial Number) \_\_\_\_\_. received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)** Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152**--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---**

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1. Applicant's election with traverse of group II in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the "light colored" and "light reflecting" both describe materials having non-light absorbing characteristics and hence, are the same. And that the top coating to the second or rear surface would be a different product which would not be image receptive. This is not found persuasive because the application fails to provide support that the phrases "light colored" and "light reflecting" have the same characteristics. It may be true that said phrases may be directed to non-light absorbing characteristics, but said phrases have distinct definition. In that, the "light colored" article does not have to be light reflective. Also, as admitted by the applicant, the top coating of the second surface would form a different product. Applicant should note that the process claims are directed to applying image to a second surface whereas the product claims 8-10 recites that the image is located on the first surface.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

3. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Shields (5,609,938).

Shields relate to a one-way, see-through panel for application through a surface. The panel comprises an opaque light reflecting substrate with pigmented adhesive layer or black color coating on one surface and a light reflective image panel on the opposite surface. The adhesive layer is provided with a protective liner. The panel is provided with a pattern of

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spaced-apart perforations and an imperforate barrier covering said release liner. Further, a protective covering can be provided for the image layer.

5. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 and 10, as stated, are formed to be confusing because it is not clear if the image is applied directly on the first surface or top of the barrier film.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,925,437.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the '437 patent and the instant application recites a one-way, see-through panel having the same structure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can normally be reached on Monday-Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Ahmad/mm

November 23, 1999

*Nasser Ahmad*  
NASSER AHMAD  
PRIMARY EXAMINER  
GROUP 1300  
TC-1700